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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,344	06/22/2001	Atsushi Tomita	AICA-24-US	8899

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EXAMINER

SHORT, PATRICIA A

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/22/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/888344

Applicant(s)

Tomita et al

Examiner

Short

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on October 22, 2002.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 5-14 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 5-14 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9, 10, 12, and 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support for the exclusion of the tackifying resin is not apparent nor is support for the result of excluding a tackifying resin apparent. At page 11, lines 4--8, tackifiers are disclosed for use in the invention and tackifiers are used in examples 1 and 4 producing adhesives that have a compression set of less than 90%, an adhesive property sufficient for use as an adhesive composition and easy disassembly property. See *Ex parte Pearson* 230 USPQ 711 (POBA 1986).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. New claims 5-14 require that the hot melt composition comprise as essential ingredients and as the only ingredients the styrene block copolymer, the polyphenylene ether resin or modified polyphenylene ether resin and a viscosity adjuster. Additionally claims 9, 10, 12 and 14 recite the result of excluding of a tackifying resin. Use of the language "comprising" with respect to the hot melt composition is confusing where the only ingredients are the styrene block copolymer, the polyphenylene ether resin or modified polyphenylene ether resin and viscosity

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adjuster. As "comprising" is an open term encompassing compositions containing ingredients other than the specified ingredients, it is not clear what is encompassed when "comprising" is used in combination with the language "the only ingredients" and thus, when the claims would be infringed. Additionally, in claims 9, 10, 12 and 14, it is not clear whether a tackifier is specifically excluded or whether the claims merely recite the result of excluding a tackifier. Finally, it is not clear that the language "flow adjuster" excludes a tackifier. Applicant argues that a flow adjuster modifies the flow properties while a tackifier provides adhesive properties. However, at page 7, last two lines through page 8, line 2 and at page 10, lines 6-9, of the response filed October 22, 2002, applicant states that a tackifier fluidizes the composition and thereby increases compression set. As applicant's flow adjusters have the same function (see the specification at page 10, lines 3-10), it is not clear how a flow adjuster and a tackifier differ for purposes of the claimed invention and thus, when the claims would be infringed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 5-9 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hansen. The reference was discussed in the previous Office action. This rejection differs in that is made under both 35 U.S.C. 102 and 103. Applicant argues that the claimed invention excludes the block A compatible resin and the tackifier taught by the reference. However, for reasons discussed above, it is not clear that the hot melt compositions exclude the block A compatible resin and tackifier. Further, with respect to the block A compatible resin that is melt blended with the polyphenylene ether resin and used as component (d) of the reference, it is noted that modified polyphenylene ether as disclosed by applicant includes polyphenylene ether blended with other resins. With respect the argument concerning the specific styrene block copolymers, these claims are not limited to those polymers. Finally, with respect to the argument concerning inherency, the compositions of the reference shown in Table 3 have high service temperature and are prepared from high molecular weight styrene block copolymer, polyphenylene ether resin and viscosity adjusters/tackifiers in amounts similar to those used by applicant. Where the reference compositions are substantially the same as the claimed compositions, the burden is upon applicant to prove that the prior art compositions do not inherently possess the claimed property. See *In re Best* 195 USPQ 430 CCPA 1977).

Claims 5-9 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO '396. The reference was discussed in the previous Office action. This rejection differs in that is made under both 35 U.S.C. 102 and 103. Applicant argues that the claimed invention excludes the tackifier taught by the reference. However, for reasons discussed above, it is not clear that the hot melt compositions exclude the tackifier. With respect to the argument concerning the low molecular weight polyphenylene ether used by the reference, the claims encompass the use of a low molecular weight polyphenylene ether. With respect the argument concerning the specific styrene block copolymers, these claims are not limited to those polymers. Finally, with respect to the argument concerning inherency, the

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compositions of the reference shown in Table 1 have high service temperature and are prepared from high molecular weight styrene block copolymer, polyphenylene ether resin and viscosity adjusters/tackifiers in amounts similar to those used by applicant. Where the reference compositions are substantially the same as the claimed compositions, the burden is upon applicant to prove that the prior art compositions do not inherently possess the claimed property. See *In re Best* 195 USPQ 430 CCPA 1977).

Claims 10, 11, 13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over WO '396. The reference is discussed above and in the previous Office action. Additionally, at page, 7, lines 4-14, the diene block of the styrene block copolymer can be hydrogenated. As suggested by the reference, it would have been obvious to hydrogenate the diene block of the styrene block copolymer thus obtaining styrene-ethylene-1-butene-styrene block copolymers or styrene-ethylene-propylene-styrene block copolymers for use in the hot melt adhesive of the reference.

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November 20, 2002

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